

REMARKS

Claims 1 and 2 are now pending in the application. By this amendment, claims 1 and 2 are amended to recite a critical upsetting ratio greater than 49%. Applicant acknowledges that entry of this amendment is not a matter of right. Notwithstanding, “[t]he refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.” See e.g., MPEP 714.13(III). As set forth in the remarks in response to the rejection under 35 U.S.C. § 103, the claimed critical upsetting ratio greater than 49% would not have been obvious in view of the cited prior art. What's more, a new search is not required because no prior art has been found by the Examiner that teaches an alloy composition that anticipates the claimed composition. Accordingly, JP '769 represents the most pertinent prior art relative to the claimed invention. Because the claims are unobvious in view of JP '769 and, therefore, in condition for allowance, the Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1 - 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 09-176769 (JP '769). This rejection is respectfully traversed.

As stated above, claims 1 and 2 have been amended to recite a critical upsetting ratio that is greater than 49%. This subject matter is described in the specification as originally filed, and particularly in Figure 3. No new matter has been added. This

amendment clarifies the critical significance of the upper limit of 0.37 wt% Mg with the claimed critical upsetting ratio.

More specifically, a wear-resistant aluminum alloy or extruded product having a critical upsetting ratio greater than 49% would not have been obvious in view of JP '769. More specifically, in Figure 1 of the present application, alloy numbers 1, 2, 5, 8, and 9 have a critical upsetting ratio greater than 49%, and alloy numbers 4, 5, 7, and 10 have a critical upsetting ratio of less than 49%. These alloys plotted on the attached graph. With respect to alloy 7, although this alloy has a Mg content within the claimed range, this alloy does not satisfy the claimed critical upsetting ratio because this alloy contains Mn in an amount that is significantly greater than those alloys (i.e., alloys 1, 2, 5, 8, and 9) that fall within the range of the claimed invention.

Applicants respectfully draw the Examiner's attention to Alloys 4 and 6, which have a Mg content of 0.37 wt% (i.e., a Mg content that touches the claimed range) and a Mg content of 0.39 wt% (i.e., a Mg content that is close to the claimed range). These alloys are significant because the Examiner alleges that "[t]hough the minimum range of Mg taught by JP '769 of 0.4% does not fall within the presently claimed maximum of 0.37%, a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected from them to have the same properties." Alloy numbers 4 and 6 in Figure 1 of the present invention, however, which contain Mg in an amount that touches (alloy 4; 0.37 wt% Mg) and is close to (alloy 6; 0.39 wt%) the range of Mg claimed, do not satisfy the claimed critical upsetting ratio greater than 49%. Accordingly, Applicant respectfully asserts that JP '769, although teaching an alloy having a content of Mg that is close to

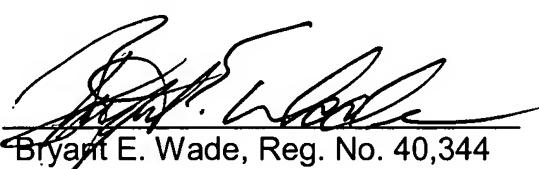
the claimed range of 0.37%, would not be expected to have the same properties as the claimed alloy having a critical upsetting ratio greater than 49%.

Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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